REMARKS

This Application has been carefully reviewed in light of the Office Action mailed June 14, 2006. At the time of the Office Action, Claims 1-3, 5-10 and 14-17 were pending in this Application. Claims 4 and 11-13 were previously withdrawn due to an election/restriction requirement. Claims 1-3, 5-10, and 14-17 stand rejected. Claims 1, 6, and 17 have been amended to further define various features of Applicants' invention. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 102

Claims 6-10 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by JP 62240237 A filed by Kawamoto Takahiro et al. ("Takahiro"). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that the cited art as anticipatory by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

Claim 6 recites "the stop can be moved upwards at an impingement angle of *more than 90 degrees* in relation to a flat plane and a direction in which the uppermost sheet is fed." (emphasis added). According to the specification,

> In order to put this effect to use, the impingement angle of the stop in relation to the flat plane of the fed sheet should be at least 90 degrees. An impingement angle of *more than 90 degrees*, most advantageously about 100 degrees, or setting the stop in a slightly tilted position in relation to the pile, has the advantage that the

> front edge of the sheet will be maintained contiguous with the stop also when the front edge of the sheet moves upwards in a bow-shaped form.

(Specification, 6:26-7:3) (emphasis added). According to the application a rolling action is exerted on the uppermost paper sheet of the stack. Thereby the upper sheets of the stack are "fanned out" in the direction of the rolling action. The front edge of the uppermost sheets only contacts the upwards moving stop (belt) at varying degrees and are lifted at varying degrees from the lower sheets of the stack. The lower sheets of the stack do not contact the stop and are not lifted.

Alternatively, Takahiro shows that the drawing belt 12 is positioned to be 90 degrees relative to the paper and teaches,

> a fine dislocation is caused among the respective paper sheets in the group of the paper sheets 18 and a larger dislocation is caused at the upper portion by the same force as compared with the lower portion due to the effect of the weight of the respective paper sheets as far as the entire group of the paper sheet 18 is concerned.

(Takahiro, abstract). Takahiro teaches an impingement angle of 90 degrees so as to apply the same contact force with all of the papers in the paper stack. With the same contact force being applied to the entire stack, only the top paper sheets become dislocated because they are not weighted down by additional paper sheets. According to Takahiro the stack of paper sheets is moved with its front side completely against the drawing belt 12 by the placing unit 17. Only in this way all the paper sheets can be lifted at their front edges by the belt 12 (in a different amount due to the effect of the weight of the papers of the upper part of the stack). Roller 1 does not contact the uppermost sheet of the stack (as can be seen from Figs. 1 and 2 of Takahiro) but drives roller 3. Thus, Takahiro teaches away from an impingement angle of more than 90 degrees. The invention as claimed in claim 6 is patentable in view of Takahiro. The invention of claims 7-10 is patentable for similar reasons.

Rejections under 35 U.S.C. §103

Claims 1-3 were rejected under 35 U.S.C. §103(a) as being unpatentable over Takahiro. Applicants respectfully traverse and submit the cited art does not render the claimed embodiment of the invention obvious.

Claim 5 was rejected under 35 U.S.C. §103(a) as being unpatentable over Takahiro in view of U.S. Patent 4,579,329 issued to Walter W. Frost et al. ("Frost"). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

Claims 14-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Takahiro in view of Frost. Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Claim 1 recites "moving the uppermost sheet with its front edge against a stop, which is moved under an impingement angle of more than 90 degrees in relation to a flat plane and a direction, in which the uppermost sheet is being fed." As noted above, Takahiro teaches away from an impingement angle of more than 90 degrees. Therefore, the invention as claimed in claim 1 is patentable in view of Takahiro. Claims 2-3 are patentable for similar reasons.

Claim 5 depends from independent claim 1 and contains all limitations thereof. 35 U.S.C. § 112, ¶ 4. Claim 5 also recites the "more than 90 degrees" limitation. As noted above, Takahiro teaches away from this configuration. Also, Frost et al. does not teach this feature. Thus, the invention as claimed in claim 5 is patentable in view of the combined teachings of Takahiro and Frost et al.

Claims 14 - 16 depend from independent claim 6 and contains all limitations thereof. 35 U.S.C. § 112, ¶ 4. Claim 14 - 16 also recite the "more than 90 degrees" limitation. As noted above, Takahiro teaches away from this configuration. Also, Frost et al. does not teach this feature. Thus, the invention as claimed in claims 14 - 16 is patentable in view of the combined teachings of Takahiro and Frost et al.

Claim 17 recites "an impingement angle of more than 90 degrees." As noted above, Takahiro teaches away from this configuration. Also, Frost et al. does not teach this feature. Thus, the invention as claimed in claim 17 is patentable in view of the combined teachings of Takahiro and Frost et al.

Association of Customer Number and Change of Correspondence Address

Applicants respectfully request that all papers pertaining to the above-captioned patent application be associated with Customer No. **31625**, and direct all correspondence pertaining to this patent application to practitioners at Customer Number **31625**. All telephone calls should be directed to William Beard at 512.322.2690.

CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2690.

Respectfully submitted,
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Date: September 13, 2006

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